

REMARKS

This application was originally filed on 21 December 2001 with nineteen claims, two of which were written in independent form. Claims 10-19 have been withdrawn. No claims have been allowed.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,153,379 to Guzik et al. ("Guzuk"). The applicant respectfully disagrees and submits the Examiner has failed to present a *prima facie* case of anticipation.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, "a person shall be entitled to a patent unless," concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham and Adams*." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it." *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

The applicant respectfully submits the Examiner has failed to meet the burden of proof required to establish a *prima facie* case of anticipation. Section 2131 of the Manual of Patent Examiner's Procedure provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987). "The

identical invention must be shown in as complete detail as contained in the . . . claim.”

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The elements must be arranged as in the claim under review. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

With respect to independent claim 1, Guzuk does not show, teach, or suggest “a corner portion of said intermediate metallization layer remaining visible beyond the extent of said upper portion for indicating an orientation of said substrate.” The Examiner stated, “Guzuk teaches . . . a corner portion of the intermediate metallization (114) layer remaining visible beyond the extent of the upper portion (104) for indicating an orientation of said substrate.” Reference to Figure 4a of Guzuk clearly shows the intermediate metallization layer of Guzuk does not indicate “an orientation of said substrate” as recited by Claim 1. Furthermore, the Examiner has not cited any teaching of Guzuk that suggests the metallization layer indicates orientation of the substrate. The Examiner’s rejection therefore is unsupported by the prior art, fails to establish a prima facie case of anticipation, and should be withdrawn.

The Examiner stated, “In response to applicant’s argument that the metallization layer remaining visible beyond the extent of said upper portion for indicating an orientation of said substrate is not given patentable weight because, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.”

The applicant respectfully submits the claimed limitation does result in a structural difference between the claimed invention and the prior art and is therefore patentably distinguished from the structure of Guzak, and from *In re Casey*, 370 F.2d 576, cited by the Examiner. *In re Casey* states, “The board found that appellant’s structure, even in view of the claim language, differed in no way from the disclosure of Kienzle.” *Id.* at 579. As best illustrated in reference to Figure 4a of Guzak, Guzak’s structure cannot indicate an orientation of the substrate as all four corners are the same.

Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,037,698 to Ueda et al. (“Ueda”). The applicant respectfully disagrees and submits the

Examiner has failed to present a prima facie case of obviousness.

The Examiner stated, "Ueda teaches . . . a corner portion of the intermediate metallization (53) layer remaining visible beyond the extend of the upper portion (6) for indicating an orientation of the substrate."

The applicant submits Ueda teaches an acoustic surface wave package in which "the metallic cap is electrically connected to one of the ground terminal of the input terminal and the ground terminal of the output terminal." (abstract) The metallization (53) the Examiner is referring to is a cap connecting pattern on the surface of substrate (5). Various additional cap connecting patterns on additional layers electrically connect this cap connecting pattern (53) to the package lid. Figures 5A, 5B, 12, 14, and 19 of Ueda show the completed package, it is clear from these figures that Ueda does not show, teach, or suggest "an intermediate metallization layer on a top surface of said lower portion . . . remaining visible beyond the extent of said upper portion for indicating an orientation of said substrate" as recited by Claim 1.

Claims 3-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Guzik. Claim 2 was rejected under 35 U.S.C. § 102(e) as being anticipated by Ueda. Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik. The applicant respectfully disagrees. Claims 2-9 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. For the reasons discussed above, the references do not show, teach, or suggest the limitations of Claim 1, much less the limitations of Claim 1 in combination with the additional limitations of Claims 2-9.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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